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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91204603
Party	Defendant Mirza Juddani
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UNITED STATES PATENT AND TRADEMARK OFFICE  
TRADEMARK TRIAL AND APPEAL BOARD

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BOMBARDIER RECREATIONAL PRODUCTS, INC.,

Opposer and  
Counterclaim-Respondent,

Opposition No. 91204603  
Serial No. 79097186

v.

MIRZA JUDDANI,

Applicant and  
Counterclaim-Petitioner.

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**APPLICANT'S MEMORANDUM IN OPPOSITION  
TO OPPOSER'S MOTION TO DISMISS COUNTERCLAIM**

Applicant, Mirza Juddani ("Juddani"), submits this Memorandum in opposition to Opposer Bombardier's ("BRP") motion to dismiss Juddani's counterclaim.

**I. Applicant's Counterclaim**

Juddani has applied to register SKIDDOO CLICK AWAY in a particular design for a variety of travel-related services in International Classes 39 and 43.<sup>1</sup> In its Notice of Opposition, BRP cites its own Reg. No. 3,673,043 for "tour guide services and travel agency services, namely, making reservations and bookings for transportation; tour guide services" in Class 39 as support for its opposition.<sup>2</sup>

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<sup>1</sup> Application Ser. No. 79097186.

<sup>2</sup> Notice of Opposition, ¶8 and Ex. B.

As a First Counterclaim in its Answer to Notice of Opposition with Counterclaim for Partial Cancellation of Reg. No. 3,673,043,<sup>3</sup> Juddani seeks to partially cancel BRP's Reg. No. 3,673,043 to the extent of canceling the registration for "tour guide services and travel agency services, namely, making reservations and bookings for transportation; tour guide services" in Class 39.<sup>4</sup> Other than Reg. No. 3,673,043, BRP has no U.S. trademark registration for travel-related or travel-booking services.<sup>5</sup>

BRP's registration is based solely upon Section 44(e), in this case upon a Canadian trademark registration.<sup>6</sup> Juddani's counterclaim is based upon the fact that BRP's "Canadian Registration did not include 'tour guide services and travel agency services, namely, making reservations and bookings for transportation; tour guide services' either in these exact words or in any other words."<sup>7</sup> Because the description of services in a U.S. registration cannot be broader than the description of services in the foreign registration upon which it is based, BRP's Reg. No. 3,673,043 should be cancelled to the extent it includes a broader description of services than the foreign registration.<sup>8</sup>

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<sup>3</sup> Answer, ¶¶32-51.

<sup>4</sup> Answer, ¶¶49-50.

<sup>5</sup> Answer, ¶51.

<sup>6</sup> Answer, ¶¶44-46, and Ex. 9 (BRP's Canadian Registration).

<sup>7</sup> Answer, ¶43. See Answer, Ex. 9 (BRP's Canadian Registration).

<sup>8</sup> See *Marmark v. Nutrexpa S.A.*, 12 U.S.P.Q. 2d 1843, 1845 (TTAB 1989), citing *In re Lowenbrau*, 175 U.S.P.Q. 178 (TTAB 1972).

## II. BRP's motion should be denied

This is a motion to dismiss under Fed.R.Civ.P. 12(b)(6) for failure to state a claim. As BRP recognizes, dismissal is appropriate only where “it appears to a certainty that [applicant] is entitled to no relief upon any state of facts which could be proved in support of the claim.”<sup>9</sup> It is also axiomatic that on such a motion, the facts in the complaint — in this instance, in the counterclaim — are presumed to be true.<sup>10</sup> In reviewing a complaint, “the Board construes the allegations therein liberally, as required by Fed.R.Civ.P. 8(f).”<sup>11</sup>

BRP's motion fails because it is based upon two faulty premises:

1. Applicant seeks to assert a counterclaim for the cancellation of the '043 Registration based on the allegation that the underlying application was incomplete because the Section 44(e) basis was insufficient for some of the services in International Class 39.
2. The determination of Opposer's compliance with the requirements of Section 44(e) was an *ex parte* examination issue addressed during the prosecution of the underlying application.<sup>12</sup>

Premise number 1 is incorrect because Juddani's counterclaim is *not* based on the contention that BRP's application was incomplete. Juddani's counterclaim is based upon the contention that at the time its U.S. registration issued, BRP had no foreign registration that

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<sup>9</sup> BRP's Motion, p.2, quoting *Stanspec Co. v. Am. Chain & Cable Co., Inc.*, 189 U.S.P.Q. 420, 422 (CCPA 1976).

<sup>10</sup> *Stanspec*, at 422.

<sup>11</sup> *Saint-Gobain Abrasives Inc. v. Unova Industrial Automation Systems Inc.*, 66 U.S.P.Q.2d 1355, 1358 (TTAB 2003).

<sup>12</sup> BRP's Motion, page 2.

included “tour guide services and travel agency services, namely, making reservations and bookings for transportation; tour guide services.”<sup>13</sup>

Premise number 2 is incorrect because the cancellation counterclaim is not based on any failure by the examiner to enforce a procedural requirement, such as requiring the filing of a foreign registration with a trademark application. It is based on a substantive deficiency, in this case, that BRP did not have a foreign registration that included “tour guide services and travel agency services, namely, making reservations and bookings for transportation; tour guide services.” The former cannot be challenged in an opposition or cancellation while the latter may be challenged.

The distinction is made clear in *Phonak Holding AG v. ReSound GmbH*,<sup>14</sup> the case upon which BRP places primary reliance. In *Phonak*, an applicant moved to amend its answer in an opposition proceeding to assert a counterclaim. The counterclaim sought to cancel an opposer’s pleaded registration because the opposer, which had obtained its registration solely under Section 44, had failed to file its foreign registration as part of its U.S. trademark application process. The TTAB held that the examiner’s failure to require the opposer to file its foreign registration in support of its own application was examination error, which is not a proper basis for an opposition or cancellation. The TTAB went on, however, to state what *would* have been a proper basis for a cancellation:

On the other hand, to state a proper ground for opposition or cancellation, an opposer or cancellation petitioner must plead not

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<sup>13</sup> Answer, ¶43.

<sup>14</sup> 56 U.S.P.Q.2d 1057 (TTAB 2000).

only that the applicant failed to submit a copy of the foreign registration, but also that the issuance of the registration was improper because, at the time the registration issued, the registrant did not own a foreign registration which could serve as a basis, under Section 44(e), for issuance of the U.S. registration.<sup>15</sup>

The TTAB then went on to discuss the *Century 21*<sup>16</sup> case, another case relied upon by BRP:

The present situation is analogous to the situation in which an opposer challenges a registration on the ground that the application was not supported by adequate specimens of use. In such a case, the Board has held that the issue of the adequacy of the specimens is solely a matter of *ex parte* examination, and that a proper ground for opposition would be that the owner of the mark had not used that mark in commerce. *Century 21 Real Estate Corp. v. Century Life of America*, 10 USPQ2d 2034, 2035 (TTAB 1989) ["it is not the adequacy of the specimens, but the underlying question of service mark usage which would constitute a proper ground for opposition."].<sup>17</sup>

*Marshall Field & Co. v. Mrs. Fields Cookies*<sup>18</sup> another case relied upon by BRP, is distinguishable on the same basis as *Century 21*. It was a case where, as in *Century 21*, the claim was that specimens were insufficient. As held in *Century 21*, whether specimens were sufficient is procedural and not a basis for opposition or cancellation. The underlying substantive issue — whether there was use in commerce — would have been a proper ground for opposition or cancellation.

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<sup>15</sup> *Phonak*, 56 U.S.P.Q.2d at 1059.

<sup>16</sup> *Century 21 Real Estate Corp. v. Century Life of America*, 10 U.S.P.Q. 2d 2034 (TTAB 1989).

<sup>17</sup> *Phonak*, 56 U.S.P.Q.2d at 1059.

<sup>18</sup> 11 U.S.P.Q.2d 1355 (TTAB 1989).

*Saint-Gobain Abrasives Inc. v. Unova Industrial Automation Systems Inc.*,<sup>19</sup> also cited by BRP, is distinguishable for a similar reason. In that case, the Board held that an opposer or a plaintiff in a cancellation proceeding could not claim the indefiniteness of a mark's description as a basis for opposing an application or canceling a mark because if the examiner had objected to the description during examination, the defendant could have submitted an acceptable description of the mark. In other words, indefiniteness was a procedural deficiency which could have been obviated during the examination process if the examiner had objected. Where the claimed deficiency was a substantive deficiency — functionality or acquired distinctiveness — the Board in *Saint-Gobain* held that a claim was stated. In this case, BRP's failure to have a foreign registration covering "tour guide and travel agency services, namely, making reservations and bookings for transportation; tour guide services" was not simply procedural and could not have been obviated during the examination process because BRP did not have a foreign registration covering those services.

As applied to this case, the holding in *Phonak* means Juddani could not challenge whether a foreign registration was filed with the examiner but Juddani could challenge whether BRP had, at the time its U.S. registration was issued, a foreign registration that covered "tour guide services and travel agency services, namely, making reservations and bookings for transportation; tour guide services." This is exactly what Juddani's counterclaim alleges. This type of allegation goes to the substantive requirements for registering a mark on a Section 44(e) basis and is nothing like challenging the examination process, such as whether a proper specimen or a foreign registration was filed.

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<sup>19</sup> 66 U.S.P.Q.2d 1355 (TTAB 2003).

In *Marmack, Ltd. v. Nutrexp S.A.*,<sup>20</sup> the Board addressed a situation identical in all material respects to this proceeding. An opposer moved 1) to amend its notice of opposition to add a second cause of action alleging that applicant should be denied a registration because the goods covered in its United States application exceeded the scope of the goods covered in the Spanish registration upon which its U.S. application was based and 2) to obtain summary judgment on the new second cause of action. The examiner had passed to publication applicant's application to cover "[c]hocolate, cocoa, strawberry and vanilla flavored milk based beverages" based upon applicant's Spanish registration for "[a]ny kind of foodstuff, — canned fish, shellfish and pickles, sauces, seasonings and spices; except any cheese, butter and casein."

The TTAB first permitted amendment of the notice of opposition. Then, it considered opposer's new cause of action on the merits. Applicant argued that its United States registration did not exceed the scope of its Spanish registration because chocolate, cocoa, strawberry and vanilla flavored milk "are foodstuffs and ... are not cheese, butter and casein." The Board noted that "because Section 44 represents an exception to the normal registration procedures, it is the policy of this Board to construe narrowly this section. *United Rum v. Distillers Corp.*, 9 U.S.P.Q.2d 1481, 1483 (TTAB 1988)" and "[a]ccordingly, we find that the description of goods set forth in the Spanish registration cannot be broadly read to include any kind of foodstuff with the exception of cheese, butter and casein. Such a broad interpretation renders meaningless the specific enumeration of foodstuffs set forth in the Spanish registration, namely, 'canned fish, shellfish and pickles, sauces, seasonings and spices.'"<sup>21</sup> Having found that

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<sup>20</sup> 12 U.S.P.Q. 2d 1843 (TTAB 1989)

<sup>21</sup> *Id.* at 1845.



the scope of goods in applicant's U.S. application was broader than the goods described in applicant's predicate Spanish registration, the Board sustained the opposition and denied registration.

Here, analogous to *Marmack*, BRP's Canadian registration<sup>22</sup> does not include "tour services and travel services, namely, making reservations and bookings for transportation; tour services." In its Motion, BRP cryptically states: "The Canadian Registration does include language which Applicant believes encompasses the Class 39 services in [Applicant's] '043 Registration."<sup>23</sup> Yet, BRP does not identify the language in its Canadian Registration that allegedly encompasses those services. In response, we note first that this is a Rule 12(b)(6) motion. Therefore, the allegations in Juddani's counterclaim — including the allegation that BRP's Canadian Registration does not include tour guide services or travel agency services<sup>24</sup> — are presumed to be true. Second, BRP's statement is simply wrong. A review of the services listed in BRP's Canadian Registration<sup>25</sup> would lead any fair-minded reader to conclude that BRP's Canadian Registration does not include "tour guide services and travel agency services, namely, making reservations and bookings for transportation; tour guide services." Significantly, BRP does not state in its motion that it has some other foreign registration — i.e. one other than the Canadian Registration submitted to the U.S.P.T.O. — that covers travel booking services or tour guide services.

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<sup>22</sup> Answer, Ex. 9 (BRP's Canadian Registration).

<sup>23</sup> BRP's Motion, p. 5.

<sup>24</sup> Answer, ¶49.

<sup>25</sup> Answer, Ex. 9 (BRP's Canadian Registration).

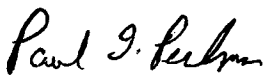
## CONCLUSION

BRP's motion to dismiss Juddani's counterclaim should be denied. BRP's U.S. Registration 3,673,043 is based solely upon a Canadian registration. The Canadian registration does not cover "tour guide services and travel agency services, namely, making reservations and bookings for transportation; tour guide services" but the U.S. Registration was issued to cover those services. Because a registration based solely on Section 44(e) cannot exceed the scope of services covered by a predicate foreign registration, and because BRP did not have at the time of registration any foreign registration covering those services, BRP's '043 registration should be partially cancelled to the extent it covers those services. Juddani's counterclaim seeking such cancellation states a claim and should not be dismissed.

In the alternative, Juddani seeks leave to replead to make clearer, if necessary, its allegation that BRP did not, at the time its U.S. Reg. 3,673,043 issued, have any foreign registration covering "tour guide services and travel agency services, namely, making reservations and bookings for transportation; tour guide services."

Dated: July 19, 2012

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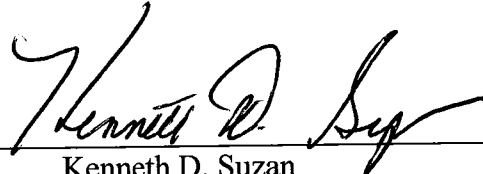
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CERTIFICATE OF SERVICE

I, Kenneth D. Suzan, hereby certify that a true and correct copy of this  
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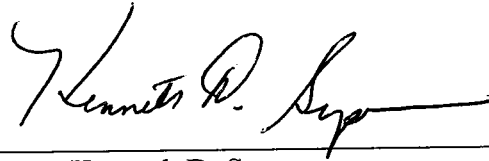
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CERTIFICATE OF FILING

I, Kenneth D. Suzan, hereby certify that this *Applicant's Memorandum in Opposition to Opposer's Motion to Dismiss Counterclaim* is being electronically filed with the Trademark Trial and Appeal Board on July 19, 2012.

A handwritten signature in cursive script, reading "Kenneth D. Suzan", written over a horizontal line.

Kenneth D. Suzan